

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Henri ROSSET**

Art Unit: **3725**

Application Number: **10/575,367**

Examiner: **Kyle R. Grabowski**

Filed: **April 11, 2006**

Confirmation Number: **3944**

For: **MULTI-LAYER SECURITY PAPER**

Attorney Docket Number: **062402**
Customer Number: **38834**

PRE-APPEAL BRIEF – REQUEST FOR REVIEW

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

June 13, 2011

Sir:

This request is being filed concurrent with a Notice of Appeal and **\$540.00** fee in compliance with 37 C.F.R. §41.31. A petition for a one-month extension of time and **\$130.00** fee are submitted with this paper.

Applicants request review of the rejections in the above-identified application. No amendments are being filed with this Request. Claims 1, 4, 9-10, 12-17, 23 and 25-41 are pending in the present application. Claims 1 and 25 are the only independent claims.

I. **Error in the objection to claim 40: “planchette” is not a synonym of “particle”**

At page 2 of the Office Action, the Examiner objects to claim 40 as failing to further limit a previous claim. However, **the Markush group of claim 1 recites “particles” whereas the Markush group of claim 40 recites “planchettes,” which is a term of art for a particular type of “particles,”** so claim 40 is not commensurate in scope with claim 1. See response filed December 1, 2011 at page 17, and Van Renesse, Optical Document Security, Artech House, Boston, Mass. Pp. 75-76 (2005) cited therein.

II. Errors in the art rejection of claims 1, 4, 9-10, 12, 14-16, 23, and 40-41: no weight given to the factual statements in Declaration under 37 C.F.R. 1.132 filed with last response

Starting at page 4 of the Office Action, independent claim 1 and claims 4, 9-10, 12, 14-16, 23, and 40-41 dependent directly or indirectly thereon are rejected under 35 U.S.C. 103(a) as obvious over US 5,565,276 to Murakami et al. (“Murakami”) in view of US 5,161,829 to Detrick et al. (“Detrick”). Claim 1 provides a multiply security paper, with a first authentication element of a first type and a second authentication element of a second type different from the first type, and (1) the first ply does not include any authentication element of the second type, and (2) the second ply does not include any authentication element of the first type. An advantage is to improve detection of the authentication elements in their separate layers.

The Examiner mentions the Declaration under Rule 1.132 by Dr. Dietemann submitted with the response of December 1, 2010 only once (Office Action at page 8, last line: “The declaration under 37 CFR 1.132 has been read and considered”), but he does not discuss at all the factual statements and explanations in the Declaration, let alone with the specificity required for meaningful examination. See MPEP 716.01(B) (“the examiner must specifically explain why the evidence is insufficient”).

In particular, first, the Examiner’s interpretation of Murakami is directly contradicted by the facts established in the Declaration. The Declaration states that Murakami is understood by the person of the art to teach that the different authentication elements are “all in a single layer” and that “combining authentication elements of different types in a single layer is not expected to pose any problem” (Declaration paragraph 4). The Declaration discusses and concludes in the same way for “dyed fibers” specifically (Declaration paragraph 5).

Second, no weight has been given to the explanation in the Declaration that “[f]rom the point of view of a person of the art concerned with the placement of these authentication features, Detrick is too general to be relevant, because it does not indicate any specific reason to modify a security paper in any particular manner” (Declaration paragraph 6). The Examiner does not explain why this factual statement has not been considered.

Third, no weight has been given to the explanation in the Declaration that the person of the art would have expected that additional authentication elements would be “‘recognized independently’ when they are included in the same layer as the nacreous fragments” (Declaration paragraph 5), whereas this observation establishes that the improved detection provided by separation in different layers as in the present invention was not predictable from Murakami. Again, the Examiner does not explain why this factual explanation has not been considered.

III. Errors in the art rejections of claims 25-35: no weight given to factual statements in Declaration under 37 C.F.R. 1.132 filed with last response

In the Office Action, independent claim 25 and claims 26-35 dependent directly or indirectly thereon are rejected under 35 U.S.C. 103(a) as obvious over US 6,402,888 to Doublet et al. (“Doublet”) in view of Detrick (with additional references for claims 26-27, 31-32 and 34). Claim 25 provides a multiply security paper with watermark and reinforcing fibers in which (1) the first ply does not include any reinforcing fibers different from the fibers of the fibrous structure of the first ply and such that the paper would have a mechanical strength higher than a mechanical strength of a paper having identical weight in g/m² and identical composition except without the reinforcing element, and (2) the second ply does not include any watermark. An advantage is that detection of the watermark is not adversely impacted by the reinforcing fibers.

Here also, the Examiner does not discuss at all the factual statements and explanations in the Declaration submitted with the response of December 1, 2010. See MPEP 716.01(B), supra.

In particular, first, the Examiner's overly broad interpretation of "reinforcing fibers" as covering "wet strength enhancers" is not supported in the record, and is directly contradicted by the Declaration, which explains that wet strength enhancers "function differently... than reinforcing fibers," which "are included in a fiber layer to increase the mechanical strength within the fiber structure, especially the dry mechanical strength," (Declaration paragraph 8). The Declaration concludes by stating that "[t]he person of ordinary skill in the art would not consider that teachings regarding wet strength enhancer resins could be replicated or are even useful to address issues related to the use of reinforcing fibers" (Declaration paragraph 8).

Second, the Examiner has stated very generally that a motivation or incentive to separate reinforcing fibers from a watermark would have been that "one of ordinary skill would realize that either layer could be solely incorporated with wet strength enhancers absent from the other ply, to provide a desired characteristic, wet strength to a particular side of the finished ply" (Office Action at page 6, first paragraph). This alleged motivation is directly contradicted by the Declaration which states that "if the objective is to reinforce a paper, the most effective manner of adding reinforcing fibers is to have the reinforcing fibers in each layer of a multiply paper" (Declaration paragraph 9). The Declaration explains that the person of the art would not find an incentive in Detrick to depart from the conventional manner of reinforcing a multiply paper, because Detrick also teaches that "[e]ach layer... may have identical mechanical properties... to achieve desired or necessary effects" (Detrick at col. 3, lines 36-37).

Third, the Declaration explains that the person of the art would have provided reinforcing fibers in all layers because this solution “would be expected to maximize the paper resistance” (Declaration paragraph 9) and “[f]rom my knowledge and experience... the person of ordinary skill in the art would not have had any reason to depart from this practice... because it would have increased complexity and cost... without any expected benefit” (Declaration paragraph 10).

The Examiner has not considered this factual statement in the Declaration.

Conclusion:

In view of the above, it is submitted that the rejections should be withdrawn. A new Office Action to this effect is respectfully requested. In particular, the Examiner’s position regarding the specific factual explanations and statements provided by Dr. Dietemann in the Declaration under 37 C.F.R. 1.132 filed on December 1, 2010 is respectfully requested.

Please charge any fees which may be required to our Deposit Account No. 502866.

Respectfully submitted,

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